

REMARKS

Claims 1 and 6 are pending in this application. The Office Action rejects claims 1 and 6 under 35 U.S.C. §112, first paragraph; and rejects claims 1 and 6 under 35 U.S.C. §102(e)/§103(a). By this Amendment, claim 1 is amended. Support for the amendments to claim 1 may be found in the present specification at, for example, page 2, line 1, Fig. 1, and page 16, lines 19-22. No new matter is added.

I. Rejection under 35 U.S.C. §112, first paragraph

Claims 1 and 6 are rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement. Specifically, the Office Action alleges that the amended lower point $S > 11$ in the equation (1) is new matter. Applicants respectfully traverse the rejection.

By this Amendment, the formula (1) in claim 1 is amended to recite " $11 \leq S \leq 17$." Applicants respectfully submit that the lower bound value of 11 is supported in the specification as originally filed at page 13, Table 1, "Silica 4." MPEP 2163.05, Section III, specifically states that the ranges of an equation may be narrowed by amending a bound value based on a specific disclosed example. In this case, "Silica 4" shown in Table 1 on page 13 of the present specification is disclosed as having a "S" value (specific surface area) of 11. The analysis of whether a particular range is new matter "must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure." *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), discussed in MPEP 2163.05, Section III.

In the present application, a person having ordinary skill in the art would consider that the range $S \geq 11$ is inherently supported by the example of "Silica 4" given in the specification, because this exact value is disclosed by the example. Accordingly, the value of

S \geq 11 does not constitute new matter, and the rejection under 35 U.S.C. §112, first paragraph, should be withdrawn.

Reconsideration and withdrawal of the rejection are respectfully requested.

II. Rejection under 35 U.S.C. §102(e)/§103(a)

Claims 1 and 6 are rejected under 35 U.S.C. §102(e) (or alternatively under 35 U.S.C. §103(a)) as anticipated by (or obvious over) Shiobara (U.S. Patent No. 6,001,901).

Applicants respectfully traverse the rejection.

Applicants respectfully submit that Shiobara does not disclose, or teach or suggest, all the features of amended independent claim 1. Specifically, Shiobara at least fails to teach or suggest "an anisotropic conductive adhesive *film*" as is presently recited. See the present specification at, for example, page 2, line 1 and Fig. 1. Instead, Shiobara merely teaches that the composition therein is an *encapsulant*, not a film. See Shiobara at abstract; column 1, lines 2-9; and column 2, lines 23-29.

Additionally, Shiobara also does not teach or suggest that the anisotropic conductive adhesive film undergoes indentation of at least 10 μm at a 1 kgf indentation strength, and undergoes indentation of at least 15 μm at an indentation strength of 2 kgf, during thermocompression bonding for 20 seconds at 180°C. See the present specification at, for example, page 16, lines 19-22; and page 18, Table 5. Shiobara nowhere discloses, or teaches or suggests, these indentation values.

Accordingly, independent claim 1 is not anticipated by, and would not have been obvious over, Shiobara for at least the reasons discussion above. Dependent claim 6 therefore also is not anticipated by, and would not have been obvious over, Shiobara for at least the reason that independent claim 1 is not anticipated by, and would not have been obvious over, Shiobara.

Reconsideration and withdrawal of the rejection are respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Enclosure:
Petition for Extension of Time

Date: December 12, 2008

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